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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,161	08/17/2001	Olivier Civelli	P-UC 4679	5376
23601	7590	05/26/2004		
CAMPBELL & FLORES LLP 4370 LA JOLLA VILLAGE DRIVE 7TH FLOOR SAN DIEGO, CA 92122			EXAMINER DEBERRY, REGINA M	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/932,161

Applicant(s)

CIVELLI ET AL.

Examiner

Regina M. DeBerry

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 11 and 12.

Claim(s) objected to: _____.

Claim(s) rejected: 1-10, 13-15, 34 and 35.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: New claims 36-38 now recite polypeptides comprising various SEQ ID NOs. The claims would entail a possible species election of a SEQ ID NO: and a sequence search on the elected SEQ ID NO: for potential art.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If the amendment was entered, the rejection of claim 2 under 112, second paragraph, as set forth at page 7 of the previous Office Action (03 November 2003) would be withdrawn.

If the amendment was entered, the rejection of claims 1, 2, 15 and 34 under 35 USC 112, first paragraph, scope of enablement, as set forth at pages 2-5 of the previous Office Action (03 November 2003) would be withdrawn.

If the amendment was entered, the rejection of claims 1, 15 and 34 under 112, first paragraph, written description, as set forth at pages 5-7 of the previous Office Action (03 November 2003) would be withdrawn.

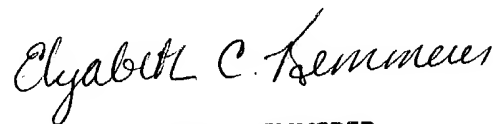
Continuation of 5. does NOT place the application in condition for allowance because: If the amendment was entered claim 35 would be rejected under 35 USC 102(a) as being anticipated by Zhang et al. (Society for Neuroscience Abstracts, 1999). The basis for this rejection is set forth at pages 7-8 of the previous Office Action (03 November 2003). Applicants maintain that without any indication that either nonREM or REM sleep was reduced by PrRP treatment, the assertion that treated rats are coming out of REM sleep is invalid. Applicants argue that Zhang et al. state that nonREM sleep was increased by 27.2%, which does not mean 27.2% reduction in REM sleep. Applicants maintain that Zhang et al. describe only increases in sleep, whether nonREM or REM sleep and increasing sleep is the opposite of promoting wakefulness. Applicants submit Exhibit A, which describes sleep stages.

Applicants' arguments have been fully considered but are not deemed persuasive. Exhibit A teaches that nonREM sleep is comprised of stages 1-4, with only stages 3 and 4 being deep sleep (slow wave). The specification describes "promoting wakefulness" to include a decrease in any stage of sleep, light sleep, deeper sleep characterized by the presence of high amplitude, low wave brain activity termed slow wave sleep and REM (specification, page 15, lines 21-30). The specification also states that a compound that promotes wakefulness can, for example, prolong normal latency to sleep or restore normal sleep patterns following sleep deprivation (specification, page 16, lines 1-6). Thus the specification like the results of Zhang et al. are open for different interpretation. At various points in the rat experiments of Zhang et al., both nonREM and REM sleep patterns were being increased.

However and most importantly, the same exact step would equal the same exact effect, it would be inherent that administered PrRP, as taught by Zhang et al., would have the property of promoting wakefulness. The prior art has all of the features required to perform the intended use recited in the instant claims, as there are no distinguishing features between the instant PrRP and the PrRP of Zhang et al. A compound and all of its properties are inseparable (In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)). The evidence as a whole indicates that the rejection should be maintained.

If the amendment was entered claims 2-10, 13, 14, 39 and 40 would be rejected under 103(a) as being unpatentable over Zhang et al. (Society for Neuroscience Abstracts, 1999) in view of Curran et al., US Patent No. 6,323,177 B1 and Roland et al., Endocrinology, 1999 (IDS submitted by Applicant). The basis for this rejection is set forth at pages 8-10 of the previous Office Action (03 November 2003). Applicants argue that the combination of Zhang et al. and Curran et al. does not teach or suggest the method of claims 1, 13 and 14. Regarding claims 2-10, Applicants maintain that the combination of Zhang et al. Curran et al. and Roland et al. does not teach or suggest the claimed methods.

Applicants' arguments have been fully considered but are not deemed persuasive. The key issue at dispute is the Zhang et al. reference. The Examiner has discussed the rejection in the maintained 35 USC 102(a) rejection. Curran et al. teach the screening of very large libraries for receptor agonists and antagonists. Roland et al. teach that PrRP binds the PrRP receptor (GPR10) and stimulates calcium mobilization. Roland et al. teach the screening of other PrRP receptor agonists. The evidence as a whole indicates that the rejection should be maintained.



ELIZABETH KEMMERER
PRIMARY EXAMINER